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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,743	02/19/2002	Douglas U. Mennie	47171-00300USC2	7973
30223	7590	03/18/2004	EXAMINER	
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			BOWER, KENNETH W	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	MENNIE, DOUGLAS U.	
10/078,743		
Examiner Kenneth W Bower	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 09 February 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 29-40,47-61 and 68-162 is/are pending in the application.  
 4a) Of the above claim(s) 35-39 and 69-162 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 29-34,40,47-61 and 68 is/are rejected.  
 7) Claim(s) 48 and 59 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 1.11.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 35-39 and 69-162 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

***Priority***

2. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

***Information Disclosure Statement***

3. The information disclosure statement filed 19 February 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

In the instant application the US references have been considered however the foreign references have not.

4. The information disclosure statement filed 09 February 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

In the instant application the US references have been considered. The foreign references with copies or translations have been considered. However the foreign

references without translations have not been considered. Therefore, there is no requirement for copies of US references or foreign references with copies or translations in English. Front pages of the foreign references requiring copies and some other information that is not readable is appended to the instant action. Examiner was unable to easily identify which line item on the IDS corresponded with each reference. Examiner will initial the foreign references on the IDS after applicant has supplied copies of translations or statements of relevance in English or has crossed references not so supplied from the IDS.

5. Special note is being made of the handling of the extensive IDS contained in the instant application.

"Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent above.

Only where the relevancy of the information is actually discussed in the application file (either by the examiner or the applicant) or where the information is relied upon to reject a claim in the application will the information be deemed to have been "considered" (to the extent discussed)..." *MPEP Section 609*

In the instant application:

- \* US Patent References: have been input by patent number into the Patent Office search engine as though they were classified in the US Patent Class/Subclass deemed by the examiner to constitute the Field of Search (same Class/Subclass list that appears on the front page of a issued US Patent) and subsequently word searched with the classified search references.

- \* Foreign Patent References: The figures of foreign patent references are looked at by the examiner. The English Abstract is read only if so warranted by relevant subject matter in the drawings.
- \* Non- Patent literature References: Drawings, Abstract or statement of relevancy and Title have been looked at by the examiner and if warranted followed by a visual scan for key words.

#### ***Drawings***

6. The 6 sheets of formal drawings were received on 27 March 2002. These drawings are approved by the examiner and placed in the file replacing their predecessors for examination.

#### ***Claim Objections***

7. Claims 48 and 59 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In the instant application the act of setting a flag commonly known in the art as meaning the setting of a bit in memory is expanded to encompass the resulting function that the set bit controls thereby expanding rather than further limiting the subject matter of a previous claim.

#### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 48 and 59, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed.

Cir. 1999). The term "act of flagging" in claim 48 and 59 is used by the claim to mean "that setting a flag includes a subsequent action by the machine in the form of stopping the machine, while the accepted meaning is "flag n. [very common] A variable or quantity that can take on one of two values; a bit, particularly one that is used to indicate one of two outcomes or is used to control which of two things is to be done."

The term is indefinite because the specification does not clearly redefine it.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 29-34, 40, 47, 61 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 4,973,851) in view of Hatanaka et al. (JP 54-71673).

Lee discloses a currency evaluation device (Abstract), single output receptacle (14), transport mechanism (belts 12 and 18 and associated drive components), transport path (shown by arrows in Fig. 1), a discriminating unit (Fig. 2 and 3), two detectors (V2 and M), on opposite sides (Fig. 1), counting (Column 7, line 38), determining denomination (column 7, line 42), means for flagging when the denomination of a bill is not determined (column 15, lines 50-52).

Lee lacks an input receptacle.

Hatanaka et al. teaches a currency evaluation device with an input receptacle for a stack of bills at (translation page 2, line 2)

It would have been obvious to one of ordinary skill at the time of the invention to combine the receptacle of Hatanaka et al. with the disclosures of Lee (US 4,973,851) to provide a stand alone currency evaluator as suggested by Lee at (column 1, lines 7-28).

Lee further discloses a plurality of currency denominations (column 2, lines 27-36), the act of halting the transporting of the bills (column 15, line 58) and the act or resuming the transporting of the bills (column 15, lines 59-60).

13. With respect to the receptacle being adapted to receive a stack of bills having a plurality of denominations Lee Modified by Hatanaka et al. meets the limitations of the claim except that it employs a receptacle of undisclosed capacity rather than a receptacle being adapted to receive a stack of bills having a plurality of denominations in order to add a way of supplying bills to be evaluated. However, one of ordinary skill would reasonably be expected to draw the inference of the teaching therefrom. Considering the disclosure of the references the specific teachings are directed to a device and method for discriminating the denomination of bills. Therefore, it would have been obvious to one of ordinary skill to apply the inferential teaching of the reference to have an input receptacle that receives a stack of bills of different denominations. In re Preda, 401 F.2d 825, 826, 159 USPQ 342,344 (CCPA 1968).

14. With respect to the discriminating unit being adapted to determine the denomination of US Currency Lee Modified by Hatanaka et al. meets the limitations of the claim except that it employs a bill that looks like a US bill at Figures 4 and 5 and does not use size as a discriminating criteria as in non US Currency rather than specifically US Currency in order to add currency to be evaluated. However, one of ordinary skill would reasonably be expected to draw the inference of the teaching therefrom. Considering the disclosure of the references the specific teachings are directed to a device and method for discriminating currency. Therefore, it would have been obvious to one of ordinary skill to apply the inferential teaching of the reference to have the ability to discriminate US currency. In re Preda, 401 F.2d 825, 826, 159 USPQ 342,344 (CCPA 1968).

15. With respect to the discriminating unit being adapted to determine the denomination of bills having the same size, Lee modified by Hatanaka et al. meets the limitations of the claim except that it employs a bill that looks like a US bill at Figures 4 and 5 and does not use bill dimensions as a discriminating criteria. However, one of ordinary skill would reasonably be expected to draw the inference of the teaching therefrom. Considering the disclosure of the references the specific teachings are directed to a device and method for discriminating currency without measuring the dimensions of the bills. Therefore, it would have been obvious to one of ordinary skill to

apply the inferential teaching of the reference to have the ability to discriminate bills of the same dimensions. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342,344 (CCPA 1968).

16. With respect to the transport transporting bills at a rate of 800 or 1,000 bills per minute Lee modified by Hatanaka et al. is considered to be an art known equivalent unless applicant can prove that the rate of transporting the bills is critical and operating at these rates results in unexpected results.

17. With respect to the method claims Lee modified by Hatanaka meets the limitations of the claimed invention except that it discloses an apparatus for counting and discriminating currency rather than the claimed counting and discriminating currency methods. Considering the disclosure of the references the specific teachings are directed to an apparatus that receives, transports, discriminates, counts currency and stops when the denomination of the currency is not determined. However, a worker in the art would reasonably be expected to draw the inference of the methods required to make and use the apparatus therefrom. Therefore it would have been obvious to one of ordinary skill to draw the claimed methods from the inferred teachings of the reference to facilitate counting and discriminating currency. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342,344 (CCPA 1968).

Lee lacks the scanning of both sides of the bill comprising the reflecting of light.

Hatanaka et al. further discloses the scanning comprising reflecting of light on one side of the bill to discriminate the denomination of bills.

It would have been obvious to one of ordinary skill at the time of the invention to replace the magnetic sensor of Lee with the scanner comprising the reflecting of light of Hatanaka et al. to discriminate bills without the use of magnetic thread in the paper.

18. Claims 33, 34, 39, 52, 53, 56 and 57 are rejected under 35 U.S.C. 103(a) as being obvious over Raterman et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Lee Modified by Hatanaka et al. lacks a specific teaching of the speed of operation of currency discriminating and counting at rates of 800 and 1000 bills per minute.

Raterman et al. discloses an apparatus and methods that achieve speed of operation of currency discriminating and counting at rates of 800 and 1000 bills per minute (DESCRIPTION OF THE PREFERRED EMBODIMENTS)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the speed of operation of Raterman et al. with the apparatus performing the same operations of Lee Modified by Hatanaka et al. to increase productivity.

19. Claims 33, 34, 39, 52, 53, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee Modified by Hatanaka et al. as applied to claims 29-34, 40, 47, 61 and 68 above, and further in view of Curl et al.

Lee Modified by Hatanaka et al. lacks a specific teaching of the speed of operation of currency discriminating and counting at rates of 800 and 1000 bills per minute.

Curl et al. discloses an apparatus and methods that achieve speed of opeation of currency discriminating and counting at rates of 800 and 1000 bills per minute (column 1, lines 8-14 and 39-44)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the speed of operation of Curl et al. with the apparatus performing the same operations of Lee Modified by Hatanaka et al. to increase productivity.

**Conclusion**

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Thie et al. discloses the setting of a flag if currency being sorted (requires discriminating) is to be rejected.

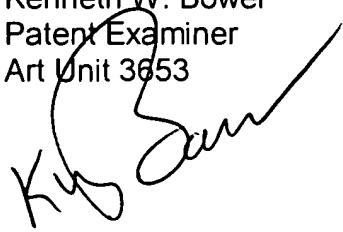
Kondo et al. discloses setting a flag when when bill is unidentified.

Kagami discloses setting a flag when bills are damaged.

McDonald et al. discloses setting a flag when bills are too long or too short.

21. Direct any inquiry concerning this or earlier communications from the examiner to Kenneth W. Bower at ken.bower@uspto.gov or (703) 306-4546. Call the examiner immediately prior to sending an unofficial fax to (703) 308-0552 or (703) 308-2571 if fax is busy. The examiner is normally available from 7:00 AM to 3:00 PM Eastern Time on Monday through Thursday and on every second Friday. The official central facsimile number for all groups is (703) 872-9306. Status or general information queries should be directed to the Group Receptionist at (703) 308-1113. If necessary, the Group Receptionist can assist with contacting the examiner's supervisor.

Kenneth W. Bower  
Patent Examiner  
Art Unit 3653



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Kwb  
10 March 2004